

1       The opinion in support of the decision being entered today was *not* written  
2           for publication and is *not* binding precedent of the Board  
3  
4  
5  
6

7           UNITED STATES PATENT AND TRADEMARK OFFICE  
8  
9

---

10           BEFORE THE BOARD OF PATENT APPEALS  
11                   AND INTERFERENCES  
12  
13

---

14           *Ex parte* ERIC ALLAN BIER  
15  
16

---

17           Appeal 2007-1105  
18           Application 09/731,912  
19           Technology Center 2100  
20  
21

---

22           Decided: June 14, 2007  
23  
24  
25  
26

---

27       *Before:* JAMES D. THOMAS, JOSEPH F. RUGGIERO, and  
28           ALLEN R. MACDONALD, *Administrative Patent Judges.*  
29

30       MACDONALD, *Administrative Patent Judge.*  
31  
32  
33  
34  
35  
36  
37

38           DECISION ON APPEAL  
39

1 STATEMENT OF CASE

2 Appellant appeals under 35 U.S.C. § 134 from a final rejection of  
3 claims 1-3, 5-13, 15-16, 18-21, and 23-45. We have jurisdiction under 35  
4 U.S.C. § 6(b). On May 23, 2007, an oral hearing was conducted regarding  
5 this appeal.

6 Appellant invented a system, method, and computer readable medium  
7 for editing group-editable electronic documents (Specification 1:5-6).  
8 Specifically, Appellant's group editing is of layout or format. (Specification  
9 2:16)

10 Representative independent claim 1 and dependent claims 34-36  
11 under appeal read as follows:

12 1. A group-editable web page editing system comprising:  
13  
14 an element selection device that selects a portion of an  
15 electronic document, wherein the selected portion includes at least one  
16 of template information or formatting information stored within the  
17 electronic document;

18  
19 an editing device that determines an edit user interface and  
20 allows editing of the selected portion through the edit user interface,  
21 wherein the edit user interface allows editing of at least one of the  
22 template information or the formatting information of the selected  
23 portion; and

24  
25 an updating device that replaces the selected portion with the  
26 edited portion.

27  
28 34. The system of claim 1, wherein the formatting information  
29 comprises at least one of text, images, and formatting codes editable  
30 by one or more authorized users, and wherein the formatting  
31 information is distinct from editable content items of the electronic  
32 document.

1  
2

3           35. The system of claim 1, further comprising a content item  
4       edit merging device that merges a modified content item back into the  
5       electronic document even if the template information or formatting  
6       information of the electronic document was altered while the content  
7       item was being modified.

8

9           36. The system of claim 1, further comprising a template edit  
10 merging device that merges a modified item template back into the  
11 electronic document even if the content of one or more items managed  
12 by the item template was altered while the item template item was  
13 being modified.

14

15 The prior art relied upon by the Examiner in rejecting the claims on  
16 appeal is:

17

Giljum US 6,745,238 B1 June 1, 2004  
(Filed Mar. 31, 2000)

20

21 *Sparrow Community-Shared Documents*, World Wide Web conference  
22 WWW7 , (April 1998).

23

24 The additional prior art cited by the Board is:

25

Skok US 2002/0091725 A1 July 11, 2002  
(Filed May 12, 1998)

28

<sup>29</sup> under 35 U.S.C. § 103(a) based on Chang and Giljum.

30

been obvious. More specifically, with respect to claims 1, 12, and 20, Appellant further contends that the reference disclosures do not disclose or suggest “storing editable template information or formatting information

1 within the electronic document" (Br. 3:4-5) or the selected (and edited)  
2 portion includes "template information or formatting information"  
3 (Br. 3:6-13).

With respect to claims 34, 38, and 42, Appellant further contends that the reference disclosures do not disclose or suggest “the formatting information is distinct from editable content items of the electronic document” (Br. 7:15-19).

With respect to claims 35, 39, and 43, Appellant further contends that the reference disclosures do not disclose or suggest “merging a modified content item back into an electronic document under the condition where template information or formatting information of the document was altered while a content item was modified” (Br. 8:1-3).

With respect to claims 36, 40, and 44, Appellant further contends that the reference disclosures do not disclose or suggest merging “a modified item template back into the electronic document even if the content of one or more items managed by the item template was altered while the item template item was being modified” (Br. 8:14-16).

18 We affirm.

**ISSUE(S)**

Has Appellant shown that the Examiner has failed to establish one skilled in the art would have incorporated editable template and format information into Chang's editing of Sparrow community-shared web page documents in such a manner as to obtain "group-editable web page editing

1 system ... [for editing] template information or formatting information  
2 stored within the electronic document" as required by claim 1?

## FINDINGS OF FACT

4        1.      Appellant invented a system, method, and computer readable  
5 medium for editing group-editable electronic documents  
6 (Specification 1:5-6). Specifically, Appellant's group editing is of layout or  
7 format. (Specification 2:16)

8           2.     Appellant admits that with Sparrow, “the page author can  
9     change the layout of such a page, or the format of its items, by reading the  
10   page into a text editor or HTML authoring tool and making edits to the  
11   overall page.” (Specification 2:7-9).

12        3. The prior art Chang reference describes the claimed  
13 group-editable web page editing system, in the form of in-place editing of  
14 Sparrow community-shared web page documents. (Chang's Title, p. 1).

15        4. The Chang reference further describes the claimed an element  
16 selection device that selects a portion of an electronic document, wherein the  
17 selected portion includes information stored within the electronic document,  
18 in the form of clicking on a black triangle (p. 3, ll. 2-3 and Figure 2). The  
19 information selected in Chang is *content* information.

20        5. The Chang reference further describes the claimed an editing  
21 device that determines an edit user interface and allows editing of the  
22 selected portion through the edit user interface, wherein the edit user  
23 interface allows editing of information of the selected portion, in the form of  
24 an editable item (p. 4, ll. 1-3). The information edited in Chang is *content*  
25 information.

1       6.     The Chang reference further describes the claimed an updating  
2 device that replaces the selected portion with the edited portion, in the form  
3 of supplanting the original (p. 4, ll. 3-5).

4       7.     The Chang reference further describes the electronic document  
5 is an HTML document with template, formatting, and content information  
6 (p. 5, ll. 16-19; p. 11, l. 5; pp. 11-12, section 4.1; and pp. 13-14,  
7 section 4.5).

8       8.     The Chang reference further describes the formatting  
9 information comprises codes which are distinct from editable content items.  
10 Page 14 shows standard “<B>” and “</B>” HTML bold formatting  
11 information stored within the electronic document and distinct content  
12 information “Abe L.” stored within the document.

13       9.     The Chang reference further describes that the formatting  
14 information is editable by an authorized user (p. 11, l. 2).

15       10.    The Chang reference further describes an edit merging device  
16 that merges first modified content information back into the electronic  
17 document even if second content information was altered while the first  
18 information was modified (p. 7, ll. 16-19; p. 14, section 4.6).

19       11.    The prior art Giljum patent teaches that it is desirable to edit the  
20 template or “style” of web pages. (Col. 8, ll. 3-5).

21       12.    The prior art Giljum patent teaches that it is desirable to edit the  
22 formatting or “fonts” of web pages. (Col. 8, ll. 52-54).

23       13.    The prior art Skok published application describes an HTML  
24 content and format editor at paragraph [0065]:

25                   [0065] Once a user is authorized to create or edit content,  
26 the user may invoke tools of the invention to create or

1 edit content on the page. In one embodiment of the  
2 invention, the tool is a thin client HTML editor. The  
3 editor may be a thin client editor that is provided as a  
4 Java™ programming language applet, or it may reside on  
5 each user's computer. The HTML editor provides the  
6 ability to perform richly formatted text editing, such as  
7 italics, bold, centered, underline, tables, links, inserting  
8 graphics, etc. The invention shows the user content and  
9 editing as it occurs in a WYSIWYG mode, as well as  
10 automatically creating HTML tags that are associated  
11 with the rich formatting. The user can choose between  
12 editing in a WYSIWYG browser emulation display, or an  
13 HTML code level where HTML tags are directly  
14 editable.

## PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. See also *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

On appeal, Appellant bears the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of Giljum with those of Chang.

4 Appellant may sustain this burden by showing that, where the  
5 Examiner relies on a combination of disclosures, the Examiner failed to  
6 provide sufficient evidence to show that one having ordinary skill in the art  
7 would have done what Appellant did. *United States v. Adams*, 383 U.S. 39  
8 (1966); *In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir.  
9 2006); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick,*  
10 *Co.*, 464 F.3d 1356, 1360-61, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006).

## § 103 ANALYSIS

With respect to claims 1, 12, and 20, Appellant argues Chang and Giljum do not disclose or suggest “storing editable template information or formatting information within the electronic document.” (Br. 3:4-5). We disagree. Our Findings of Fact 7-9 show that Appellant is clearly in error. We find that, in Chang, the template, formatting, and content information in the electronic document are all editable and that Appellant discloses editing content information using the same content information editor as in Chang (Specification 4:31-32). Appellant’s claims differ from Chang only with respect to the type of editor used to edit template or formatting information.

With respect to claims 1, 12, and 20, Appellant also argues Chang and Giljum do not disclose or suggest the selected (and edited) portion includes “template information or formatting information” (Br. 3:6-13). Again we disagree. Chang teaches Appellant’s claimed invention (Findings of Fact 3-6) except for the specific information to be selected and edited being

1 template or formatting information. Both Chang and Giljum teach the  
2 desirability of editing template or format information (Findings of Fact 9 and  
3 11-12). Thus, we conclude that the references provide a sufficient  
4 suggestion to those skilled in the art to modify the Chang system to include  
5 group editing of template or formatting information in addition to Chang's  
6 group editing of content information.

7 With respect to claims 34, 38, and 42, Appellant argues that Chang  
8 and Giljum do not disclose or suggest "the formatting information is distinct  
9 from editable content items of the electronic document" (Br. 7:15-19). We  
10 disagree. Our Findings of Fact 7-9 show that Appellant is again in error.  
11 We find that, in Chang, the template, formatting, and content information in  
12 the electronic document are all editable and are all distinct.

13 With respect to claims 35, 39, and 43, Appellant argues that Chang  
14 and Giljum do not disclose or suggest "merging a modified content item  
15 back into an electronic document under the condition where template  
16 information or formatting information of the document was altered while a  
17 content item was modified" (Br. 8:1-3). We disagree. Our Finding of Fact  
18 10 shows that Chang teaches merging first modified content information  
19 back into the electronic document even if second content information was  
20 altered while the first information was modified. That is, "[p]ages are not  
21 locked during [group] editing" and edits must be resolved by the user only if  
22 "an edit to the [same] item has occurred." (Chang 14). Thus, we conclude  
23 that the references provide a sufficient suggestion to those skilled in the art  
24 to modify the Chang system to permit merging of modified first information  
25 back into the electronic document even if second information was altered

1 while the first information was modified, so long as the first and second  
2 information are not the same information.

3 With respect to claims 36, 40, and 44, Appellant argues that Chang  
4 and Giljum do not disclose or suggest merging “a modified item template  
5 back into the electronic document even if the content of one or more items  
6 managed by the item template was altered while the item template item was  
7 being modified” (Br. 8:14-16). We disagree. This is the same underlying  
8 issue as with claims 35, 39, and 43, and we reach the same conclusion for  
9 the same reasons.

10 Because our § 103 analysis based on the Chang and Giljum references  
11 differs from that of the Examiner at key points, we designate our decision as  
12 a new ground of rejection under 37 C.F.R. § 41.50(b).

13 37 C.F.R. § 41.50(b) provides that, “[a] new grounds of rejection  
14 pursuant to this paragraph shall not be considered final for judicial review.”

15 37 C.F.R. § 41.50(b) also provides that the Appellant, *WITHIN TWO*  
16 *MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the  
17 following two options with respect to the new grounds of rejection to avoid  
18 termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims:

19 (1) *Reopen Prosecution*. Submit an appropriate amendment of the  
20 claims so rejected or new evidence relating to the claims so rejected,  
21 or both, and have the matter reconsidered by the examiner, in which  
22 event the proceeding will be remanded to the examiner ...  
23

24 (2) *Request rehearing*. Request that the proceeding be reheard under  
25 [37 C.F.R.] § 41.52 by the Board upon the same record ...  
26  
27

1 CONCLUSION OF LAW

2 (1) Appellant has failed to establish that the Examiner erred in  
3 rejecting claims 1-3, 5-13, 15-16, 18-21, and 23-45 as being unpatentable  
4 under 35 U.S.C. § 103(a) over Chang and Giljum.

5 (2) Claims 1-3, 5-13, 15-16, 18-21, and 23-45 are not patentable.

6 DECISION

7 The Examiner's rejection of claims 1-3, 5-13, 15-16, 18-21, and 23-45  
8 is affirmed.

9 No time for taking any subsequent action in connection with this  
10 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

11

12 AFFIRMED  
13 37 C.F.R. § 41.50(b)

14

15

16

17

18 tdl/gw

19

20

21

22 GUNNAR G. LEINBERG  
23 NIXON PEABODY LLP  
24 CLINTON SQUARE  
25 P.O. BOX 31051  
26 ROCHESTER, NY 14603

27